

200976US-99



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

RECEIVED

SEP 17 2003

RECEIVED SEP 17 2003

IN RE APPLICATION OF:

:

VLADIMIR M. DOROSHENKO

:EXAMINER: SOUW, BERNARD E.

SERIAL NO: 09/828,828

:

FILED: APRIL 10, 2001

:GROUP ART UNIT: 2881

FOR: TIME-OF-FLIGHT/ION TRAP MASS
SPECTROMETER, A METHOD, AND ...

PROVISIONAL ELECTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

SIR:

In response to the Restriction Requirement dated August 13, 2003, Applicant elects with traverse Group I, Claims 1-63, drawn to ion mass spectrometer and methods of operation. Applicant makes this election based on the understanding that Applicant is not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicant respectfully traverses this Restriction Requirement for the reason that the inventions of Groups I and II have not been shown to be distinct in the manner required by M.P.E.P. §806.05(c).

As the noted portion of the M.P.E.P. indicates, the Patent Office must demonstrate either (1) that a combination as claimed does not require the particulars of the subcombination as claimed *for patentability* and (2) that the subcombination can be shown to have utility either by itself or in other and different relations. The Restriction Requirement

asserts that:

....the combination as claimed does not require the particulars of the subcombination as claimed because ion mass spectrometers can be generally operated without using any computer program.¹

However, this assertion by the Patent Office that the claimed combinations does not require the particulars of the subcombination for patentability is without a demonstration that the combination as claimed does not require the particulars of the subcombination for patentability, as no prior art is cited. Thus, it is respectfully submitted that the outstanding restriction cannot be said to have met the requirement of MPEP §806.05(c). Accordingly, the restriction is traversed.

Furthermore, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention all relate to mass spectrometry and appear to be part of an overlapping search area. Accordingly, Applicant respectfully traverses the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, whereas it would clearly be burdensome on the Applicant to be required to file, prosecute, and maintain separate applications and patents on the identified.

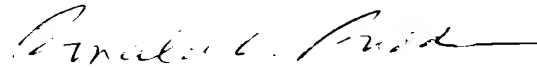
¹Office Action, page 2, lines 16-18.

Application No. 09/828,828
Reply to Office Action of August 13, 2003

Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-71 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Philippe J.C. Signore, Ph.D.
Registration No: 43,922
Ronald A. Rudder, Ph.D.
Registration No: 45,618

CUSTOMER NUMBER

22850

Tel. No.: (703) 413-3000

Fax No.: (703) 413-2220

PJCS:RAR:clh

E:\atty RAR\restrictions\200976US elect1.wpd